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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,979	06/10/2002	Patrick S. Schnable	08411-013002	1138
7590 02/08/2006			EXAMINER	
Fish & Richardson Suite 3300 60 South Sixth Street Minneapolis, MN 55402			MILLER, MARINA I	
			ART UNIT	PAPER NUMBER
			1631	
DATE MAILED: 02/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/031,979

Applicant(s)

SCHNABLE ET AL.

Examiner

Marina Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-50 and 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-50 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/4/02; 8/12/02</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicants' submission filed on 11/17/2005 is acknowledged. Claims 32-50 and 55 are pending. Claims 1-31 and 51-54 are cancelled. Claims 32-50 and 55 presently are under examination.

Applicants' arguments have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are applied.

#### ***Information Disclosure Statement***

Applicants requested the return of the initialed copy of the IDS filed 4/1/2002 because applicants have not received the copy. The examiner apologizes for the omission. The initialed copy of the IDS is attached to the instant Office Action.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 32, 41-45, and 48-50, and 55 are rejected under 35 U.S.C. 102(a) as being anticipated by Winzeler, *Science*, 281:1194-1197 (21 August, 1998).

The instant claims were previously rejected over Winzeler. Applicants argue that Winzeler does not teach different collections of fractioned genomic nucleic acids. The applicants' arguments have been fully considered the, but are found not persuasive.

Winzeler discloses sets of samples (two yeast strains and segregates, p. 1195, left col.). For at least two strains, genomic DNA was isolated, fragmented by DNase I (note 11, p. 1196), and hybridized to an array (p. 1194, middle col). Two analyzed yeast strains comprise different

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genomic regions, and therefore do represent two different collections of fractioned genomic nucleic acids (p. 1195, left col.). Furthermore, segregates also comprise distinct loci (p. 1195, left col.), and therefore represent a different collection of fractioned genomic nucleic acids. Thus, for the reasons stated above and in the previous office action, the examiner maintains that Winzeler discloses different collections of fractioned genomic nucleic acids, and thus anticipates the instant claims.

### ***Claim Rejections - 35 USC § 103***

Claims 33-34 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winzeler *Science*, 281:1194-1197 (21 August, 1998), as applied to claims 32, 41-45, and 48-50 above, in view of Biro, WO 98/30721, and further in view of Gardiner, *Genetics*, 134:917-930 (July, 1993).

The instant claims were previously rejected over Winzeler, in view of Biro and Gardiner. Applicants argue that Winzeler does not teach all limitations of the method of claim 32. Applicants do not specifically address the rejection over the combination of references.

The examiner maintains that Winzeler teaches different collections of fractioned genomic nucleic acids, as set forth in the rejection under 35 U.S.C. 102 and maintained above. Thus, the rejection over Winzeler, Biro, and Gardiner is maintained.

Claims 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winzeler *Science*, 281:1194-1197 (21 August, 1998), as applied to claims 32, 41-45, and 48-50 above, in view of Bowen U.S. Patent 6,541,684, and in view of Micheltmore, PNAS, 88:9828-32 (1991).

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The instant claims were previously rejected over Winzeler, in view of Bowen and Micheltmore. Applicants argue that Winzeler does not teach all limitations of the method of claim 32. Applicants do not specifically address the rejection over the combination of references.

The examiner maintains that Winzeler teaches different collections of fractioned genomic nucleic acids, as set forth in the rejection under 35 U.S.C. 102 and maintained above. Thus, the rejection over Winzeler, Bowen, and Micheltmore is maintained.

Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winzeler *Science*, 281:1194-1197 (21 August, 1998), as applied to claims 32, 41-45, and 48-50 above, in view of Dong, U.S. Patent 6,361,947.

The instant claims were previously rejected over Winzeler, in view of Dong. Applicants argue that Winzeler does not teach all limitations of the method of claim 32. Applicants do not specifically address the rejection over the combination of references.

The examiner maintains that Winzeler teaches different collections of fractioned genomic nucleic acids, as set forth in the rejection under 35 U.S.C. 102 and maintained. Thus, the rejection over Winzeler and Dong is maintained.

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Miller whose telephone number is (571)272-6101. The examiner can normally be reached on 8-5, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph. D. can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**MARJORIE A. MORAN**  
**PRIMARY EXAMINER**

Marina Miller  
Examiner  
Art Unit 1631

MM

*Marjorie A. Moran*  
2/2/06